

Attorney's Docket No. 11087-004001

## REMARKS

All claims remain rejected under Section 103(a) as unpatentable over at least Fredlund (5,666,215) and Johnson (6,052,670). As discussed below, Applicants traverse the rejections and respectfully submit that all claims are in condition for allowance.

Fredlund shows a system where a photographic image can be viewed at a customer's location on her personal computer and images selected for initial printing, reprinting and ordering related image services. The Office Action noted that "[t]he difference between Fredlund and the claimed invention is that Fredlund discloses sending multiple orders to a plurality of recipients instead of a single order specifying a plurality of recipients. Johnson discloses, in lines 60-62 of column 22, an electronic catalog wherein customers can place orders such that 'each order may have multiple ship addresses and multiple order items'. It would have been obvious to one of ordinary skill in the art at the time the invention was made for the single received order of Fredlund to specify a plurality of recipients, and for each specified recipient, to have a set of one or more images associated with that recipient as taught by Johnson. By doing this the ordering process of Fredlund would be streamlined and much more efficient."

Applicants disagree. To further distinguish the claims, Applicants have amended the independent claims to recite prior to printing, dividing the received order into a plurality of sub-orders, each sub-order corresponding to a different recipient. The Office Action is simply silent on addressing the rejection of this element recited in claim 15 and Applicants submit that, among others, the prior art does not show at least this aspect.

Applicant notes that the present rejection does not establish *prima facie* obviousness under 35 U.S.C. § 103 and M.P.E.P. §§ 2142-2143. The Examiner bears the initial burden to establish and support *prima facie* obviousness. *In re Rinehart*, 189 U.S.P.Q. 143 (CCPA 1976). To establish *prima facie* obviousness, three basic criteria must be met. M.P.E.P. § 2142. First, the Examiner must show some suggestion or motivation, either in the Johnson et al. reference or in the knowledge generally available to one of ordinary skill in the art, to modify the reference Fredlund so as to produce the claimed invention. M.P.E.P. § 2143.01; *In re Fine*, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). Secondly, the Examiner must establish that there is a reasonable expectation of success for the modification. M.P.E.P. § 2142. Thirdly, the Examiner must establish that the prior art references teach or suggest all the claim

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limitations. M.P.E.P. §2143.03; *In re Royka*, 180 U.S.P.Q. 580 (CCPA 1974). The teachings, suggestions, and reasonable expectations of success must be found in the prior art, rather than in Applicant's disclosure. *In re Vaeck*, 20 U.S.P.Q.2d 1438 (CAFC 1991). Applicant respectfully submits that a *prima facie* case of obviousness has not been met because the Examiner's rejection fails on at least two of the above requirements.

5           Applicant traverses the comparison. Here, Johnson shows an object oriented framework mechanism for an electronic catalog. The electronic catalog framework includes core classes and extensible classes that allow a framework consumer to implement a desired electronic catalog. As discussed on Col. 17, lines 16-49, the electronic catalog allows users 10 to select from a common list of products to all customers. However, this shopping modality is different than that for photo printing, where each image is unique. Each user uploads images in his or her account. The images in each user's account are completely personalized to the user. An electronic catalog that can be viewed and selected by all users does not simply exist in photo printing in the instant application. Applying Johnson's teaching to Fredlund 15 would not have resulted in an operable system since there is no common list of products/services such as those found in a catalog.

A catalog is geared to selling standardized products that can be catalogued. In contrast, in the photography field, each image product is unique and individualized. The concept of a catalog selling custom/individualized images in single quantity is inapposite. Hence, Fredlund does not allow a user to order for multiple recipients at different addresses 20 in one order wherein each recipient can receive different photo products in such an order. Similarly, Johnson's electronic catalog does not describe such method of submitting one order having different recipients wherein each recipient receives different products. One skilled in the art would not have combined a catalog system such as Johnson with the 25 Fredlund catalog to provide uniquely individualized photo products as in the claimed invention.

The combination suggested in the office action was done using selective hindsight. There is no suggestion or motivation in Johnson to modify Fredlund to arrive at a computer-implemented method of distributing image prints to a plurality of recipients by receiving an 30 order specifying a plurality of recipients and, for each specified recipient, a set of one or more images associated with that recipient; for each of the plurality of recipients specified in

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the received order, printing at least one copy of each image in the recipient's image set; and distributing the printed image copies to their respective associated recipient.

Applicant points out that the Examiner bears the initial burden of factually establishing and supporting any *prima facie* conclusion of obviousness. *In re Rinehart*, 189 U.S.P.Q. 143 (CCPA 1976); M.P.E.P. § 2142. If the Examiner does not produce a *prima facie* case, the Applicant is under no obligation to submit evidence of nonobviousness. *Id.* In the instant case, the Examiner has not pointed to any evidence in Johnson or how knowledge of those skilled in the art, provide a suggestion or motivation to modify the reference teaching so as to produce the claimed invention of claim 1 of a single order with multiple recipients. See *In re Zurko*, 59 U.S.P.Q.2d 1693 (Fed. Cir. 2001) ([I]n a determination of patentability .... the Board cannot simply reach conclusions based on its understanding or experience - or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings).

Under *Vaeck*, absent any evidence of a cited suggestion or reasonable motivation in the Johnson reference, or knowledge of those skilled in the art, for a single order specifying a plurality of recipients, *prima facie* obviousness of claim 1 (and dependent claims) has not been established. As such, it is respectfully requested that the § 103(a) rejection of independent claims (and dependent claims) be withdrawn and the claims be allowed.

The dependent claims overcome the Section 103 rejection because they depend from allowable independent claims. Further, Applicants note that the MPEP Section 2143.01 - Suggestion or Motivation To Modify the References – has pronounced that a statement that modifications of the prior art to meet the claimed invention would have been "well within the ordinary skill of the art at the time the claimed invention was made" because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references.

#### CONCLUSION

Applicants believe that the above discussion is fully responsive to all grounds of rejection set for the in the Office Action.

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Even though the claims prior to this amendment are patentable over the references, Applicants made the amendment without prejudice to expedite this case since none of the references show at least this aspect.

5 If for any reasons the Examiner believes a telephone conference would in any way expedite resolution of the issues raised in this response, the Examiner is invited to telephone the undersigned at 408-528-7490.

Respectfully submitted,



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